

REMARKS

Claims 1-67 are pending herein. By the Office Action, claims 7-17 and 32-66 are withdrawn from consideration; claims 1-6, 18-21, 24-25, and 28 are rejected under 35 U.S.C. §102(b); and claims 1-6 and 18-31 are rejected under 35 U.S.C. §103(a). By this Amendment, the specification and claims 1, 4-7, 34 and 41-43 are amended and new claim 67 is added. No new matter is added. Support for new paragraph [0045.1] of the specification can be found in U.S. Patent Application No. 09/919,877 filed August 2, 2001, which is incorporated into the present application at paragraph [0044].

An Information Disclosure Statement with Form PTO-1449 was filed on January 7, 2002. Although Applicants received initialed copies of the Forms PTO-1449, one reference was not initialed as having been considered of record. In particular, on page 3 of 4, the Examiner did not initial or otherwise refer to the Mimura non-patent reference. The Examiner is requested to initial and return to the undersigned a copy of the subject Form PTO-1449. For the convenience of the Examiner, a copy of that form is attached.

I. Restriction Election

Claims 7-17 and 32-66 are withdrawn from consideration as subject to a Restriction and Election of Species Requirement.

A. New Claim 67 Should be Grouped With the Elected Claims

New claim 67 is added, which depends from claim 1. Claim 67 should be grouped and examined with the elected claims.

B. Claims 7 and 8 Should Not be Withdrawn From Consideration

Initially, Applicants respectfully submit that claims 7-8 are improperly indicated as withdrawn from consideration. Claim 7 specifies that the stabilizer is curcumin or a curcumin derivative, and thus is generic to or encompasses the elected species. Claim 8 depends from claim 7, and specifies that the stabilizer is selected from the group consisting of

curcumin, demethoxycurcumin, bisdemethoxycurcumin, tetrahydrocurcumin, tetrahydrodemethoxycurcumin, tetrahydrobisdemethoxycurcumin, other curcumin metabolites, (4-hydroxy-3-methoxycinnamoyl)methane, bis(4-hydroxycinnamoyl)methane, hexahydrocurcumin, octahydrocurcumin, and mixtures thereof, and thus specifically includes the elected species. The Office Action further indicates that the elected tetrahydrocurcumin was searched, but not found.

To clarify the claims, claim 7 is amended herein to depend from claim 4. This amendment is made merely to clarify that the compounds of claims 7 and 8 are sub-species of the claim 4 oil-soluble herbal extract, where claim 4 specifically recites curcumin, and derivatives thereof. Accordingly, claims 7 and 8 should be rejoined with claims 1-6 and 18-31.

C. The Restriction Requirement Should be Withdrawn

Applicants respectfully submit that the Restriction Requirement should be withdrawn, at least because rejoinder will be required. As Applicants' previously stated, Group I is directed to a composition. Group II is directed to a method of making the composition of Group I, and Group III is directed to a method of using the composition of Group I.

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.*

In the present application, the method claims of Groups II and III include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of Groups II and III, since at least claims 32 (Group II) and 65 (Group III) depend directly from claim 1.

Since the method claims of Groups II and III include the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

D. Election of Species Requirement

Applicants thank the Examiner for the indication that the search within the species of Group I has been expanded, since tetrahydrocurcumin was not found. Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.

II. §102 Rejection

Claims 1-6, 18-21, 24-25, and 28 are rejected under 35 U.S.C. §102(b) over Miyami. Applicants respectfully traverse this rejection.

Miyami is cited as disclosing a composition that includes a vinyl resin solution, benzyl butyl phthalate, ethyl cyanoacrylate, tannic acid (a stabilizer) and tin fluoride. However, Miyami does not anticipate the claimed invention.

By this Amendment, claim 1 (and claim 34) is amended to exclude tannic acid from the scope of the claimed invention. Miyami does not disclose an adhesive composition comprising: a polymerizable 1,1-disubstituted ethylene monomer; and at least one stabilizer selected from the group consisting of herbal extracts, alpha- and beta- hydroxycarboxylic acids and salts thereof, ceramides, anti-inflammatories, vasoconstrictors, and mixtures thereof, wherein when the stabilizer is an herbal extract, it is selected from the specified group of compounds that does not include tannic acid. At most, Miyami discloses only the

use of various conventional stabilizers for stabilizing a cyanoacrylate component, but does not disclose the stabilizers of the claimed invention.

Accordingly, Miyami does not anticipate the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

III. §103 Rejections

A. Miyami

Claims 1-6 and 18-28 are rejected under 35 U.S.C. §103(a) over Miyami. Miyami is cited as described above. The Office Action then asserts that various limitations of the dependent claims would have been obvious over Miyami. Applicants respectfully traverse this rejection.

As described above, Miyami is cited as disclosing a composition that includes a vinyl resin solution, benzyl butyl phthalate, ethyl cyanoacrylate, tannic acid (a stabilizer) and tin fluoride. However, Miyami does not teach or suggest the claimed invention.

By this Amendment, claim 1 (and claim 34) is amended to exclude tannic acid from the scope of the claimed invention. Miyami does not teach or suggest an adhesive composition comprising: a polymerizable 1,1-disubstituted ethylene monomer; and at least one stabilizer selected from the group consisting of herbal extracts, alpha- and beta-hydroxycarboxylic acids and salts thereof, ceramides, anti-inflammatories, vasoconstrictors, and mixtures thereof, wherein when the stabilizer is an herbal extract, it is selected from the specified group of compounds that does not include tannic acid, as claimed in claim 1.

At most, Miyami discloses only the use of various conventional stabilizers for stabilizing a cyanoacrylate component. However, Miyami does not teach or suggest the incorporation of at least one stabilizer into the composition, where the stabilizer is broadly selected from the claimed group consisting of specified herbal extracts, alpha- and beta-hydroxycarboxylic acids and salts thereof, ceramides, anti-inflammatories, vasoconstrictors,

and mixtures thereof. Miyami does not teach or suggest that the disclosed and otherwise conventional stabilizers could or should be substituted by other compounds, without adversely affecting the stability and use of the composition.

Accordingly, Miyami would not have rendered obvious the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Miyami and Papay

claims 1-6 and 29-31 are rejected under 35 U.S.C. §103(a) over Miyami in view of Papay. Miyami is cited as described above. Papay is cited for its disclosure of the use of antioxidant stabilizers. The Office Action then asserts that various limitations of the dependent claims would have been obvious over Miyami and Papay. Applicants respectfully traverse this rejection.

As described above, Miyami is cited as disclosing a composition that includes a vinyl resin solution, benzyl butyl phthalate, ethyl cyanoacrylate, tannic acid (a stabilizer) and tin fluoride. Papay is cited for its disclosure of antioxidant stabilizers.

However, regardless of Papay's disclosure of antioxidant stabilizers, Papay does not overcome the deficiencies of Miyami, discussed above. Accordingly, any combination of Miyami and Papay would not have rendered obvious the claimed invention.


Accordingly, Miyami and Papay, alone or in combination, would not have rendered obvious the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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Attachment:
Form PTO-1449

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